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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/669,594	09/26/2000	Prasad Raje	004426.P001	5001

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EXAMINER
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BASHORE, WILLIAM L

ART UNIT	PAPER NUMBER
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2176

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/669,594

Applicant(s)

RAJE, PRASAD

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 126-142 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 126-142 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

1. This action is responsive to communications: RCE/Amendment, filed 11/12/2004, to the original application filed 9/26/2000, with provisional filing date of 9/30/1999. IDS filed 5/4/2001.
2. Claims 126-142 pending. Claims 126, 132, 137 are independent claims.

#### ***Continued Examination Under 37 CFR 1.114***

3. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/12/2004 has been entered.

#### ***Claim Rejections - 35 USC § 103***

4. **The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:**

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 126-142 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holt et al. (hereinafter Holt), U.S. Patent No. 5,557,723 issued September 1996, in view of Hitchcock et al. (hereinafter Hitchcock), U.S. Patent No. 6,460,042 issued October 2002, and in view of Texier (hereinafter Texier), U.S. Patent No. 5,119,476 issued June 1992.**

**In regard to independent claim 126**, Holt teaches a method of customizing and transmission of forms between users via an electronic mail system. A form is developed (authored) by a user, said form containing input fields (Holt Abstract, column 3 lines 5-15, column 4 lines 13-16, Figure 3; compare with claim 126 “*A method comprising: receiving a form authored by a user....one or more input fields*”). It is noted that a person designated as a form designer can also be a “user”.

The limitation of a form authoring language would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Holt, because Holt teaches customization/creation of forms (Holt Abstract, Figure 3). Since it is known that input form creation typically involves a language tailored to such creation (i.e. Pearl), it would have been obvious to the skilled artisan to use such a language providing Holt the advantages that a specific authoring language provides, such as efficient form authoring (compare with claim 126 “*a form authoring language*”).

Holt does not specifically teach parsing a form to identify fields. However, Hitchcock teaches a universal forms engine for form customization of on-line forms (Hitchcock Abstract). Hitchcock teaches an application description file which is parsed to build a corresponding HTML form (Hitchcock column 10 lines 42-46; compare with claim 126 “*parsing the received form to identify the input fields contained in the received form*”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock’s parsing method to Holt, providing Holt the benefit of parsing a form to accurately identify input field placement and function.

Holt teaches a user specifying field layout and field behavior of a custom form (Holt column 2 lines 1-5). Holt also teaches a final customized graphical input form displayed to a user within a graphical user interface (Holt Figure 3). Holt does not specifically teach that the user can define actions (after parsing, etc.) with the GUI dependent on the identified input fields. However, Texier teaches a forms creation method comprising creation and modification of a form(s) using Windows graphics mode (Texier Abstract). Texier teaches that a user can both use the final form, and/or edit said form (i.e. identify actions, add/remove fields, etc.) within the same graphic environment (Texier Figures 1-3, also Abstract). Texier also teaches in Figure 1 a distinction between operations “NEW EMPLOYEE”, and “SEE/MODIFY EMPLOYEE” (see Texier Figure 1 at upper left),

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therefore defining a dependency between the graphical interface (comprising its fields), and the above operations (selection “NEW EMPLOYEE” is dependent upon all fields to be initially blank). The user can edit accordingly. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Texier to Holt, providing Figure 3 item 302 of Holt the benefit of an expanded and modifiable user information directory to add to its library user interface (compare with claim 126 “*providing a graphical user interface to the user to allow....on the identified input fields*”).

Holt teaches a customized input form (Holt Figure 3) in which a user can specify field layout and behavior of input fields (Holt column 2 lines 3-5). Holt teaches a “Form Control Procedure” (FCP) to implement user defined processing of said form (Holt column 2 lines 45-53). Since input form behaviors are generally implemented by code instructions, user customization results in a form of “automatic” customization of the code constructs so as to carry out the user’s alterations. Holt, however, does not forcefully recite “automatic” code generation. However, Texier teaches a forms editor comprising an editing area with creation, modification and linking of skeleton objects (Texier Figures 2-3, column 17 lines 20-68, also column 18 lines 15-30), the completion of which will automatically create the necessary code constructs in order to create said form. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Texier to Holt, providing Holt the benefit of a more convenient way to create forms (compare with claim 126 “*automatically generating a program code to carry out the actions identified by the user.*”).

**In regard to dependent claims 127, 128,** Holt teaches e-mail forms (Holt Title, Figure 3). Holt does not specifically teach HTML, or CGI. However, Hitchcock teaches form customization using HTML, as well as CGI (Hitchcock column 4 lines 4-10, 30-35). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply Hitchcock to Holt, providing Holt the benefit of a popular language and program suited for the addition and processing of input forms.

**In regard to dependent claims 129, 130,** claims 129, 130 incorporate substantially similar subject matter as claimed in claim 126, and in further view of the following, is rejected along the same rationale.

Holt teaches a custom form containing a form control procedure (Holt column 25-29). Holt also teaches receiving a form with input data (Holt Abstract). Holt's form acts upon the input data by detecting whether said data exists in form fields, enabling/disabling fields accordingly (Holt column 5 lines 26-33).

**In regard to dependent claim 131**, Holt teaches an indication that a Form Control Procedure (FPC) will be called periodically to ensure consistency of a form customized to update the time (Holt column 5 lines 12-15).

Generating an alert if the program code is not consistent with the form would have been obvious to one of ordinary skill in the art at the time of the invention, because Holt teaches periodic updating of the time on a form using generated FPC code (Holt column 5 lines 12-15). Since display of the wrong time typically conveys an implicit message to the user that something is wrong (i.e. update via FCP failed), the use of an alert in cases of inconsistency would have been obvious to the skilled artisan, providing Holt the benefit of increased time accuracy.

**In regard to independent claim 132**, claim 132 reflects the system comprising computer readable instructions used for implementing the methods as claimed in claim 126, and is rejected along the same rationale.

**In regard to dependent claim 133**, Holt teaches customization of electronic forms using e-mail, which typically involve a plurality of processors (Holt Title, Abstract).

**In regard to dependent claims 134, 135, 136**, claims 134, 135, 136 132 reflect the system comprising computer readable instructions used for implementing the methods as claimed in claims 127, 128, 131 respectively, and are rejected along the same rationale.

**In regard to claims 137-142**, claims 137-142 reflect the computer program product comprising computer readable instructions used for implementing the methods as claimed in claims 126-131 respectively, and are rejected along the same rationale.

***Response to Arguments***

6. Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

*William L. Bashore*  
**WILLIAM BASHORE**  
**PRIMARY EXAMINER**  
*July 23, 2006*